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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/052,771

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John A. Schillinger

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12/31/2008

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EXAMINER

PARA, ANNETTE H

ART UNIT

PAPER NUMBER

1661

MAIL DATE

DELIVERY MODE

12/31/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/052,771	Applicant(s) SCHILLINGER ET AL.	
	Examiner ANNETTE H. PARA	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10,25,33,35,39,42 and 43 is/are pending in the application.
- 4a) Of the above claim(s) 25,33,35,39,42 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12182008</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR § 1.114, including the fee set forth in 37 CFR § 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR § 1.114, and the fee set forth in 37 CFR § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR § 1.114.

Applicant's submission filed on 12 September 2007 has been entered.

Claim Rejections - 35 USC § 103

Claims 1, 2, 4-10, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Barry *et al* (U.S. Patent 5,463,175) in view of Strauch *et al*. (U.S. Patent 5,276,268) and Kishore *et al*. (U.S. Patent 5,312,910) and in further view of Shah *et al* (U.S. Patent 5,188,642).

Barry *et al* teach introducing a transgene encoding the glyphosate tolerant GOX (glyphosate oxidase) and a transgene encoding a sulfonylurea-resistant form of the maize acetolactate synthase gene (ALS) into a corn cell (columns 37 and 38). Barry *et al* teach using selecting transformed corn cells on both glyphosate and chlorsulfuron. Barry *et al* teach a glyphosate tolerant corn plant at claim 22.

Barry *et al* do not specifically teach introducing both a glyphosate tolerant CP4 EPSPS or a GOX transgene and an ALS transgene into a soybean. Barry *et al* do not teach a plant with a phosphinothricin-resistance gene.

Strauch *et al*. teach isolating and incorporating in plant the PTC gene resistant to glufosinate herbicide

Shah *et al* teach a transgene encoding a petunia EPSPS enzyme resistant to glyphosate and a soybean and cotton plant transformed therewith (claims 19 and 23).

Kishore *et al* teach a transgene encoding a maize EPSPS enzyme resistant to glyphosate and a method of using a plant transformed therewith to selectively control weeds in a field (claim 5). Kishore *et al* teach that soybean, cotton and maize can be transformed with said transgene (column 5, lines 59-62).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicants' invention to use the teachings of Barry *et al* to introduce both a GOX transgene and an herbicide resistant PCT

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transgene into soybean and regenerate a transgenic herbicide resistant plant. Barry *et al* teach that plants, which can be made glyphosate tolerant, include soybean at column 26, line 45, and claim 22. Given the success of Barry *et al* in introducing both of said transgenes into corn cells and selecting transformants on chlorsulfuron, and demonstrated that the GOX transgene produced Roundup (glyphosate) tolerance in transgenic soybean (columns 37 and 38) one of ordinary skill in the art would have had a reasonable expectation of success. It would have been *prima facie* obvious to one of ordinary skill in the art at the time of Applicants' invention to modify the teachings of Barry *et al* to use the glyphosate tolerant EPSPS transgene of Shah *et al* combined with a herbicide tolerant PCT transgene of Strauch *et al.* to transform soybean plants. The use of herbicide resistant plants to control weeds by application of the corresponding herbicide was obvious to one of ordinary skill in the art in view of the teachings of Kishore *et al.*

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2, 4-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 of U.S. Patent No. 6,376,754. Although the conflicting claims are not identical, they are not patentably distinct from each other because the species of the claims of the issued patent render obvious the genus encompassed by the instant claim

Claims 1, 2, 4-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,710,368. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because the species of the claims of the issued patent render obvious the genus encompassed by the instant claim

Conclusion

No claims are allowed.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (571) 272-0982. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg, can be reached at (571) 272-0975. The fax number for the organization where the application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/Annette H Para/
Primary Examiner

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